

REMARKS

These amendments have been made in response to a non-final Office Action dated June 14, 2007. In that Office Action, Examiner Reilly rejected the pending claims under 35 USC 103(a) and obviousness-type “Double Patenting” grounds.

In this amendment, no claim amendments add any new matter to the application as filed. With respect to all amendments and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter. Moreover, Applicants have not acquiesced to any characterizations of the invention, nor any rejections or objections of the claims, made by the Examiner.

In addition, the Examiner is encouraged to review the art made of record, any Office Action, and any Notice of Allowance in the following related patents and applications:

U.S. Patent No. 6,343,314
U.S. Patent No. 6,237,025
U.S. Patent No. 6,212,547
U.S. Patent No. 5,978,835
U.S. Patent No. 5,915,091
U.S. Patent No. 5,896,500
U.S. Patent No. 5,884,039
U.S. Patent No. 5,867,654
U.S. Patent No. 5,854,893
U.S. Patent No. 5,802,294
U.S. Patent No. 5,758,079
U.S. Patent No. 5,689,641
U.S. Patent No. 5,617,539
Application No. 11/737,723
Application No. 11/669,003
Application No. 11/668,625
Application No. 11/625,330
Application No. 11/624,860
Application No. 11/623,630
Application No. 11/623,387
Application No. 11/623,177
Application No. 11/622,583
Application No. 11/622,627
Application No. 11/265,394
Application No. 11/265,059
Application No. 11/265,256

Application No. 11/264,936
Application No. 11/264,926
Application No. 10/721,905
Application No. 10/382,554

Applicants assume that due to the ease of review on PAIR by the Examiner, Applicants need not submit copies of the individual Office Actions and/or Notices of Allowance.

Applicants assume that the Examiner is aware that prosecution is ongoing in many of these cases, and that the Examiner will continue to evaluate these cases as needed.

Further, Applicants disagree with all of Examiner's rejections as stated in the Office Action.

Nonetheless, in this amendment independent Claims 37 and 61 are each currently amended such that the entire body of issued independent claim 33 of U.S. Patent No. 6,237,025 is incorporated into the amended independent claims. Independent Claim 49 is amended to include the entire body of issued independent claim 22 of U.S. Patent No. 5,758,079. The '025 and '079 patents have the same specification and claim the same priority as this application.

Specifically, issued independent Claim 33 of US patent **6,237,025** reads:

33. A method for conducting a teleconference among a plurality of participants, each having an associated video capture and display and audio capture and reproduction capabilities, the method comprising the steps of:

- (a) maintaining
 - (i) at least one directory, including
 - (1) a list of potential participants; and
 - (ii) at least one database, including
 - (1) addresses of video display devices, and
 - (iii) an association
 - (1) between the information in the directory and the database
 - (2) in which the association is dynamically changeable;
- (b) displaying
 - (i) participant information from at least the directory
- (c) selecting
 - (i) one or more participants
 - (1) from among the displayed participant information; and

- (d) establishing communication
 - (i) with each selected participant
 - (ii) using information in the database.

Similar language is also found in claim 23 of the '025 patent. Examiner Dinh allowed this application based on comments made by Applicants in the Response and Amendment filed March 20, 2000 (see page 23), which led to allowance.

(See page 23 of Applicants' March 20, 2000 Response included herein as Appendix A)

In addition, issued claim 22 of U.S. Patent **5,758,079** reads:

22. A method for conducting a teleconference among a plurality of participants, comprising the steps of:

- (a) detecting an incoming teleconference call, from at least one calling participant, at the workstation of a first participant during an active teleconference with a second participant;
- (b) notifying the first participant of the identity of each of the calling participants ; and
- (c) providing the first participant with the option of accepting the incoming teleconference call.

Similar language is also found in Claim 1 of the '079 patent. This amendment was expressly approved by the USPTO. Specifically, Examiner Dinh stated his reasons for allowance of this patent that:

“the prior art of record does not teach or suggest the claimed feature of notifying a receiving participant, during a first active call, of a new incoming conference call and identifying each participant in the new incoming conference call.”

(See the reasons for allowance on p. 2 of the Notice of Allowance included herein as Appendix B)

The Examiner's attention is drawn to the fact that, in making these amendments certain changes to the copied issued claims' language had to be made to conform to the language of the claims on file.

In addition, in claims 37 and 61, Applicants did not copy the entire language for claim 33 as similar language was already in claims 37 and 61. Specifically, Applicants did not copy:

- “(c) selecting
 - (i) one or more participants

- (1) from among the displayed participant information;
and
- (d) establishing communication
 - (i) with each selected participant
 - (ii) using information in the database."

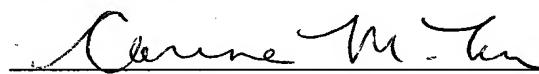
Since independent claims 37, 49, and 61 of this application include limitations from an issued claim from at least one patent by the same Applicants and claiming the same priority date, Applicants submit that all pending claims in this application are in condition for allowance.

Further, Examiner's provisional rejections under the judicially created doctrine of obviousness-type double patenting are now moot in view of the amendments to these claims and the amendments made to claims in the applications used to support the double patenting rejection. Thus, Applicants respectfully submit that all the Examiner's rejections including provisional rejections under the judicially created doctrine of obviousness-type double patenting have been overcome.

In view of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-7559, if a telephone call could help resolve any remaining items.

Respectfully submitted,

Date: December 14, 2007


Carina M. Tan 45,769
(Reg. No.)
MORGAN, LEWIS & BOCKIUS LLP
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, CA 94306
(650) 843-4000

APPENDIX A

Attorney Docket No: COLB-601/20US



#101
SPT
PATENT 3x9.00

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on March 18, 2000.

By: 

Elaine Calimquim

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Lester F. Ludwig, et al

Serial No.: 08/994,848

Examiner: Dinh, D.

Filed: December 19, 1997

Art Unit: 2757

For: MULTIMEDIA COLLABORATION SYSTEM

RECEIVED
TC 2700 MAIL ROOM
MAR 28 2000

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO OFFICE ACTION

In response to the office action dated September 30, 1999, Applicants respectfully request reconsideration based the following amendments and comment:

IN THE SPECIFICATIONS

Please amend the specifications as follows:

Change Page 1, lines 4 and 5, from:

"This application is a continuation-in-part of U.S. Application Serial No. 08/131,523, filed October 1, 1993 pending." to "This application is a continuation of U.S. Applications Serial No. 08/660,461, filed June 7, 1996, now U.S. Patent No. 5,802,294, which is a continuation of U.S. Serial No. 08/131,523, filed October 1, 1993, now U.S. Patent No. 5,689,641. --

03/22/2000 NINHANNE 00000079 08994848

01 FC:203
02 FC:202

405.00 0P
78.00 0P

1

489488 v1/PA
@H_W011.DOC
030800/1535

72

C

IN THE CLAIMS

Please amend the claims as follows:

1. ~~21.~~ (Amended) A teleconferencing system for conducting a teleconference among a plurality of participants comprising:

- (a) a plurality of video display devices each having associated
 - (i) participant video capture capabilities, and
 - (ii) participant audio
 - (1) capture and
 - (2) reproduction capabilities; and
- (b) at least one communication path
 - (i) along which signals
 - (1) representing participant audio and video
 - (ii) can be transmitted,

wherein the system maintains

- (a) at least one directory, including
 - (i) a list of potential participants; and
- (b) at least one database, including
 - (i) addresses of video display devices, and
 - (ii) audio and video capabilities of each video display device, and
- (c) an association
 - (i) between the information in the directory and the database; and

wherein the system is configured to

- (a) display[.] information from
 - (i) at least the [a first and a second] directory
 - [(1) of potential participants
 - (2) in which the second directory is a subject of the first directory,]
 - (ii) on at least one video display device; and
- (b) to initiate collaboration

(i) upon a selecting participant selecting
(1) one or more participants
 i. from the displayed [potential] participant[s]
 information and
(ii) then establishing communication
(1) with each selected participant[.]
(2) using information in the database
(3) to define a teleconference.

22. (Amended) The teleconferencing system of claim 21, wherein
(a) the [second] participant information is displayed in two sets in which the second set
[directory] includes at one least of the group consisting of

(i) displayed icons and text
[(ii)] (1) representing the potential participants.

35. (Amended) The teleconferencing system of claim 21, wherein

(a) a selecting participant can
(i) select
 (1) at least one of the participants and
 (2) at least one of a set of displayed communication types; and
wherein the system is further configured to
(i) establish communication
 (1) of the selected type
 (2) with each selected participant.

24. The teleconferencing system of claim 25, wherein
(a) the set of communication types includes at least one of:
(i) data conferencing, videoconferencing, telephone conferencing, sending faxes, sending electronic mail, and the sending of multimedia mail messages.

5
25. (Amended) The teleconferencing system of claim 23, wherein

(a) the selecting participant can use

- (i) at least one computer graphic user interface
- (ii) to select
 - (1) at least one of the participant(s) and/or
 - (2) at least one of the collaboration types.

6
26. The teleconferencing system of claim 23, wherein the system

(a) defaults

- (i) to a default collaboration type
- (ii) upon selection of a participant.

7
27. The teleconferencing system of claim 21, wherein the system is further configured to allow a participant:

(a) to select

- (i) a further participant
- (ii) from the potential participants and

(b) add

- (i) the new participant
- (ii) to an existing teleconference call.

8
28. (Amended) The teleconferencing system of claim 21, wherein the system is further configured to:

(a) allow

- (i) at least one participant
- (ii) access
 - (1) to at least one audio and/or video signal source; and

(b) reproduce

- (i) audio and/or video
 - (1) based on signals
 - (2) from the accessed signal source

(ii) for another participant.

11
29. (Amended) A method for conducting a teleconference among a plurality of participants, each having an associated video capture and display and audio capture and reproduction capabilities, the method comprising the steps of:

(a) maintaining

(i) at least one directory, including

(1) a list of potential participants; and

(ii) at least one database, including

(1) addresses of video display devices, and

(2) audio and video capabilities of each video display device, and

(iii) an association

(1) between the information in the directory and the database;

([a]b) displaying

(i) participant information from at least the [a first and a second] directory

[(1) of potential participants in which

(2) the second directory is a subset of the first directory]

([b]c) selecting

(i) one or more participants

(1) from among [a plurality of] the displayed [potential] participant[s] information; and

([c] d) establishing communication

(i) with each selected participant

(ii) using information in the database.

12
30. (Amended) The method of claim *29*, wherein *11*

(a) the [second] participant information is displayed in two sets in which the second set [directory] includes at least one of the group consisting of

(i) displayed icons and text

(1) representing potential participants.

13 32. 11 Delete Claim 31

(Amended) The method of claim 29, further comprising the steps of:

(a) selecting a communication type,

(i) from a displayed set of communication types; and

(b) establishing communication

(i) of the selected type,

(ii) with each selected participant[(s)].

14 35. 13 The method of claim 32, wherein

(a) the set of communication types includes at least one of:

(i) data conferencing, videoconferencing, telephone conferencing, sending faxes, sending electronic mail and sending multimedia mail messages.

15 34. 13 The method of claim 32, wherein

(a) the step of selecting

(i) one or more participants

(ii) invokes a default collaboration type.

16 35. 11 The method of claim 29, further comprising the steps of:

(a) selecting

(i) a new participant

(ii) from among a plurality of potential participants; and

(b) adding

(i) the new participant

(ii) to an existing teleconference.

17
36.

The method of claim 29, further comprising the steps of:

- (a) detecting,
 - (i) during a first teleconference
 - (1) between a first and a second participant,
 - (ii) an attempt
 - (1) by a third caller
 - (2) to initiate a second teleconference
 - (3) with the second participant;
- (b) notifying
 - (i) the second participant
 - (ii) of the attempt; and
- (c) allowing the second participant
 - (i) to add
 - (ii) the third caller
 - (iii) to the first teleconference.

18
37.

The method of claim 29, further comprising the steps of:

- (a) allowing at least one participant
 - (i) access to at least one audio and/or video signal source; and
- (b) reproducing video and/or audio
 - (i) based on signals,
 - (ii) from the accessed signal source;
 - (iii) for another participant.

19
38.

The method of claim 29, further comprising the step of:

- (a) allowing a participant
 - (i) in an existing teleconference with
 - (1) a plurality of other participants
 - (ii) to place on hold
 - (iii) at least one of the other participants.

20
39.

The method of claim 29, further comprising the step of:

3

(a) allowing a participant
(i) in an existing teleconference with
(1) a plurality of other participants
(ii) to disconnect
(iii) at least one of the other participants.

Please add the following new claims:

9 40. The system of claim 21, wherein the association between the information in the directory and the database is dynamically changeable.

10 41. The method of claim 29, wherein the association between the information in the directory and the database is dynamically changeable.

10 42. The system of claim 21, wherein

(a) a selecting participant can
(i) select
(1) at least one of the participants
(2) using a hot key.

11 43. The method of claim 29, further comprising the steps of:
(a) selecting a participant
(i) by using a hot key.

44. A teleconferencing system
for conducting a teleconference
among a plurality of participants comprising:
(a) a plurality of video display devices each having associated
(i) participant video capture capabilities, and
(ii) participant audio
(1) capture and
(2) reproduction capabilities; and
(b) at least one communication path
(i) along which signals

C4

(1) representing participant audio and video
(ii) can be transmitted,
wherein the system is configured to
(a) display
(i) a first and a second directory of potential participants in which
(1) the first directory is viewable by all potential participants, and
(2) the second directory is a subset of the first directory and viewable by a single participant,
(ii) on at least one video display device; and
(b) to initiate collaboration
(i) upon a selecting participant selecting
(1) one or more participants
i. from the displayed potential participants, and
(ii) then establishing communication
(1) with each selected participant.
(2) to define a teleconference.

45. The teleconferencing system of claim 44, wherein

(a) the second participant directory includes at least one of the group consisting of
(i) displayed icons and text
(1) representing the potential participants

46. The teleconferencing system of claim 44, wherein

(a) a selecting participant can
(i) select
(1) at least one of the participants and
(2) at least one of a displayed set of communication types; and
wherein the system is further configured to
(i) establish communication
(1) of the selected type

(2) with each selected participant.

47. The teleconferencing system of claim 46, wherein
(a) the set of communication types includes at least one of:
(i) data conferencing, videoconferencing, telephone conferencing, sending faxes, sending electronic mail, and the sending of multimedia mail messages.

48. The teleconferencing system of claim 46, wherein
(a) the selecting participant can use
(i) at least one computer graphic user interface
(ii) to select
(1) at least one of the participant(s) and/or
(2) at least one of the collaboration types.

49. The teleconferencing system of claim 46, wherein the system
(a) defaults
(i) to a default collaboration type
(ii) upon selection of a participant.

50. The teleconferencing system of claim 44, wherein the system is further configured to allow a participant:
(a) to select
(i) a further participant
(ii) from the potential participants and
(b) add
(i) the new participant
(ii) to an existing teleconference call.

51. The teleconferencing system of claim 44, wherein the system is further configured to:
(a) allow

Q4

- (i) at least one participant
- (ii) access
 - (1) to at least one audio and/or video signal source; and

(b) reproduce

- (i) audio and video
 - (1) based on signals
 - (2) from the accessed signal source
- (ii) for another participant.

52. The system of claim 44, wherein

(a) a selecting participant case

- (i) select
 - (1) at least one of the participants
 - (2) using a hot key.

53. A method for conducting a teleconference among a plurality of participants, each having an associated video capture and display and audio capture and reproduction capabilities, the method comprising the steps of:

(a) displaying

- (i) a first and a second directory of potential participants in which
 - (1) the first directory is viewable by all potential participants, and
 - (2) the second directory is a subset of the first directory and viewable by a single participant

(b) selecting

- (i) one or more participants
 - (1) from among a plurality of the displayed potential

participants; and

(c) establishing communication

(i) with each selected participant

54. The method of claim 53, wherein

(a) the second participant directory includes at least one of the group consisting of

(i) displayed icons and texts

(1) representing potential participants.

55. The method of claim 53, further comprising the steps of:

(a) selecting

(i) one or more desired participants

(ii) from the first participant directory; and

(b) selecting

(i) one or more desired participants;

(ii) from the second participant directory; and

(c) establishing communication

(i) with all selected participants.

56. The method of claim 53, further comprising the steps of:

(a) selecting a communication type,

(i) from a displayed set of communication types; and

(b) establishing communication

(i) of the selected type,

(ii) with each selected participant(s).

57. The method of claim 56, wherein

(a) the set of communication types includes at least one of:

(i) data conferencing, videoconferencing, telephone conferencing, sending faxes, sending electronic mail and sending multimedia mail messages.

58. The method of claim 56, wherein

(a) the step of selecting

(i) one or more participants
(ii) invokes a default collaboration type.

59. The method of claim 53, further comprising the steps of:

(a) selecting
(i) a new participant
(ii) from among a plurality of potential participants; and
(b) adding
(i) the new participant
(ii) to an existing teleconference.

60. The method of claim 53, further comprising the steps of:

(a) detecting
(i) during a first teleconference
(1) between a first and a second participant,
(ii) an attempt
(1) by a third caller
(2) to initiate a second teleconference
(3) with the second participant;
(b) notifying
(i) the second participant
(ii) of the attempt; and
(c) allowing the second participant
(i) to add
(ii) the third caller
(iii) to the first teleconference.

61. The method of claim 53, further comprising the steps of:

(a) allowing at least one participant
(i) access to at least one audio and/or video signal source; and
(b) reproducing video and/or audio
(i) based on signals,

(ii) from the accessed signal source;
(iii) for another participant.

62. The method of claim 53, further comprising the step of:

(a) allowing a participant
(i) in an existing teleconference with
(A) a plurality of other participants
(ii) to place on hold
(iii) at least one of the other participants.

63. The method of claim 53, further comprising the step of:

(a) allowing a participant
(i) in an existing teleconference with
(1) a plurality of other participants
(ii) to disconnect
(iii) at least one of the other participants.

64. The method of claim 53, further comprising the steps of:

(a) selecting a participant
(i) by using a hot key.

2365. A teleconferencing system
for conducting a teleconference
among a plurality of participants comprising:

(a) a plurality of video display devices each having associated
(i) participant video capture capabilities, and
(ii) participant audio
(1) capture and
(2) reproduction capabilities; and
(b) at least one communication path
(i) along which signals

24

(1) representing participant audio and video
(ii) can be transmitted,
wherein the system maintains
(a) at least one directory, including
(i) a list of potential participants; and
(b) at least one database, including
(i) addresses of video display devices, and
(c) an association
(i) between the information in the directory; and the database
in which the association is dynamically changeable; and
wherein the system is configured to
(a) display information from
(i) at least the directory
(ii) on at least one video display device; and
(b) to initiate collaboration
(i) upon a selecting participant selecting
(1) one or more participants
i. from the displayed participant information and
(ii) then establishing communication
(1) with each selected participant
(2) using information in the database
(3) to define a teleconference.

25 23

66. The teleconferencing system of claim 65, wherein
(a) the participant information is displayed in two sets in which the second set
includes any one or more of the group consisting of
(i) displayed icons and text
(1) representing the potential participants.

25 23
67. The teleconferencing system of claim 65, wherein

(a) a selecting participant can

- (i) select
 - (1) at least one of the participants and
 - (2) at least one of a set of displayed communication types; and

wherein the system is further configured to

- (i) establish communication
 - (1) of the selected type
 - (2) with each selected participant.

26 25
68. The teleconferencing system of claim 67, wherein
(a) the set of communication types includes at least one of:
(i) data conferencing, videoconferencing, telephone conferencing, sending faxes, sending electronic mail, and the sending of multimedia mail messages.

27 25
69. The teleconferencing system of claim 67, wherein
(a) the selecting participant can use

- (i) at least one computer graphic user interface
- (ii) to select
 - (1) at least one of the participant(s) and/or
 - (2) at least one of the collaboration types.

28 25
70. The teleconferencing system of claim 67, wherein the system
(a) defaults

- (i) to a default collaboration type
- (ii) upon selection of a participant.

29 23
71. The teleconferencing system of claim 65, wherein the system is further configured to allow a participant:
(a) to select

- (i) a further participant
- (ii) from the potential participants and

(b) add
(i) the new participant
(ii) to an existing teleconference call.

30
31 The teleconferencing system of claim 68, wherein the system is further configured

to:

(a) allow
(i) at least one participant
(ii) access
(1) to at least one audio and/or video signal source; and
(b) reproduce
(i) audio and/or video
(1) based on signals
(2) from the accessed signal source
(ii) for another participant.

31
32 The system of claim 65, wherein the database further includes audio and video capabilities of each video display device.

32
33 The system of claim 65, wherein

(a) a selecting participant can
(i) select
(1) at least one of the participants
(2) using a hot key

33
36. A method for conducting a teleconference among a plurality of participants, each having an associated video capture and display and audio capture and reproduction capabilities, the method comprising the steps of:

(a) maintaining
(i) at least one directory, including
(1) a list of potential participants; and
(ii) at least one database, including
(1) addresses of video display devices, and
(iii) an association
(1) between the information in the directory and the database
(2) in which the association is dynamically changeable;
(b) displaying
(i) participant information from at least the directory
(c) selecting
(i) one or more participants
(1) from among the displayed participant information; and
(d) establishing communication
(i) with each selected participant
(ii) using information in the database.

34
37. The method of claim 36, wherein
(a) the participant information is displayed in two sets in which the second set includes anyone or more of the group consisting of

(i) displayed icons and text
(1) representing potential participants.

35 *33* The method of claim *35*, further comprising the steps of:

- (a) selecting a communication type,
 - (i) from a displayed set of communication types; and
- (b) establishing communication
 - (i) of the selected type,
 - (ii) with each selected participant.

36 *35* The method of claim *35*, wherein

- (a) the set of communication types includes at least one of:
 - (i) data conferencing, videoconferencing, telephone conferencing, sending faxes, sending electronic mail and sending multimedia mail messages.

55
9/20/01

37 *35* The method of claim *35*, wherein

- (a) the step of selecting
 - (i) one or more participants
 - (ii) invokes a default collaboration type.

38 *33* The method of claim *35*, further comprising the steps of:

- (a) selecting
 - (i) a new participant
 - (ii) from among a plurality of potential participants; and
- (b) adding
 - (i) the new participant
 - (ii) to an existing teleconference.

39 *33* The method of claim *35*, further comprising the steps of:

- (a) detecting
 - (i) during a first teleconference
 - (1) between a first and a second participant,
 - (ii) an attempt
 - (1) by a third caller
 - (2) to initiate a second teleconference

(3) with the second participant;

- (b) notifying
 - (i) the second participant
 - (ii) of the attempt; and
- (c) allowing the second participant
 - (i) to add
 - (ii) the third caller
 - (iii) to the first teleconference.

40
32. The method of claim 25, further comprising the steps of:

- (a) allowing at least one participant
 - (i) access to at least one audio and/or video signal source; and
- (b) reproducing video and/or audio
 - (i) based on signals,
 - (ii) from the accessed signal source;
 - (iii) for another participant.

41
33. The method of claim 25, further comprising the step of:

- (a) allowing a participant
 - (i) in an existing teleconference with
 - (1) a plurality of other participants
 - (ii) to place on hold
 - (iii) at least one of the other participants.

42
33. The method of claim 25, further comprising the step of:

- (a) allowing a participant
 - (i) in an existing teleconference with
 - (1) a plurality of other participants
 - (ii) to disconnect
 - (iii) at least one of the other participants.

A 33
35. The method of claim 75, wherein the database further includes audio and video capabilities of each video display device.

A 33
36. The method of claim 75, further comprising the steps of:

(a) selecting a participant
(i) by using a hot key.

REMARKS

The specification has been amended to correctly reflect the priority chain of this application.

In the Examiner's September 1999 Office Action, pending claims 21 to 39 were rejected on two grounds. The first is an obviousness-type double-patenting rejection based on U.S. Patent 5,768,510 and the second is an obviousness rejection based on a combination of two references.

Obviousness-Type Double-Patenting Rejection

Applicants have reviewed US 5,768,510 entitled "Object-Oriented System, method and Article of Manufacture for a Client-Server Application Enabler System," in light of the double patenting rejection. It seems, from this review, that this patent's claims do not claim subject matter even remotely similar to this application's claims. For example, the '510 patent claims are not at all related to video-conferencing or to displaying at least one directory of potential video/teleconference participants. Applicant's, therefore, request that this rejection be withdrawn.

It is, of course, possible that the Examiner had a different patent in mind and, if so, Applicants would be willing to consider any other double patenting rejection the Examiner wishes to raise.

Obviousness Rejection

Claims 21 to 39 have been rejected as being obviousness based on a combination

of U.S. Patent 5,195,086 (Baumgartner, et al.), and a paper authored by Rangan, et al. In support of this rejection, the Examiner argues that:

Baumgartner does not specifically disclose first and second directory in which the second directory is a subject of the first directory... [and]

Baumgartner does not specifically disclose usage of video or video capture capabilities. Rangan teaches a system for video/audio conferencing with video capture capabilities. It would have been obvious for one of ordinary skill in the art to have video with Baumgartner system because it would have enhanced the collaborative interactions among the users.

Applicants do not agree that is obvious to combine Baumgartner and Rangan as alleged by the Examiner, nor do they agree that the combination necessarily teaches all the elements of the claims as examined. Nonetheless, Applicants have amended claims 21 to 39 and have also added new claims 41 to 86. The amendments and the comments below will, it is submitted, overcome these rejections.

Claims 21 to 43

In claims 21 through 43, the claims have been amended to contain limitations to the contents of what was originally referred to as the first and second directories. The first directory is now referred to as a "directory" and the second directory as a "database." The directory (originally the first directory) is limited to include a list of potential participants, while the database (originally the second directory) is now limited to include addresses of video display devices as well as information on their capabilities. Previously, both directories together contained only participant information.

Support for the limitations to the contents of the database (previously the second directory in the examined claims) can be found in the description of the Directory Server 66 and the Service Server Module 69, at for example, page 32, line 19 to page 35, line 17 of the application as filed.

In addition, these claims also include a limitation to the effect that the system maintains an association (a word more appropriate than the word "subject" originally used in Claim 21) between information in the directory and the database. This association is also shown in the descriptions referred to above.

Neither Baumgartner nor Rangan teach or remotely suggest any of these limitations and Applicants submit these claims are now patentable.

Claims 44 to 64

Claims 44 to 64 maintains the "two directory" language of the claims as examined, in which a second directory is a subset of a first directory. But the claims have been amended to include a limitation so that the first directory is a "universal" directory which is viewable by all participants, while the second directory is a "personal" directory viewable by only one participant. Disclosure for this concept can be found in numerous places, for example at page 31, lines 6-14 and page 35 lines 21 to 66 and in Figures 20 and 22 in the application as filed.

Rangan does not appear to teach directories and Baumgartner does not, by the Examiner's own admission, "specifically disclose first and second directories."

Given that Baumgartner does not teach a first and a second directory, it does definitely does not teach the concept of a universal and a personal directory as now claimed. Applicants submit that this claimed universal and a personal directory was not obvious in the videoconferencing field, particularly not at the time of filing.

Claims 65 to 86

Claims 65 onward are similar to claims 21 through 43 in that the concept of a directory and a database are reflected. In these claims, however, the association between the directory and the database is dynamically changeable.

Disclosure for this can be found on Page 34, lines 21 to 30 and Pages 35, lines 1 to seven, especially lines 3 to 4.

Furthermore, Applicants submit that the combination of references relied on by the Examiner, does not teach or suggest all the elements and, therefore, cannot be used to support a *prima facie* case of obviousness as required by the MPEP¹. Accordingly, it is believed that these claims are all patentable and allowance is requested.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (650) 843-5000.

¹ M.P.E.P § 2142.

The Commissioner is hereby authorized to charge any underpayment of the following fees associated with this communication, or credit any overpayment to Deposit Account No. 03-3117:

- Any national application filing fees under 37 CFR 1.16.
- Any patent application methoding fees under 37 CFR 1.17.

Cooley Godward LLP
Attn: Patent & Technology Law Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663
CPO:fh

By:

Respectfully submitted,
COOLEY GODWARD LLP


Craig P. Opperman
Reg. No. 37,078

APPENDIX B



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/660,805	06/07/96	LUDWIG	L VCOR-001710U

COOLEY GODWARD CASTRO
HUFFLESON & TATUM
FIVE PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO CA 94306

LM21/0219

EXAMINER

DINH, D

ART UNIT	PAPER NUMBER
2756	13

02/19/98

DATE MAILED:

NOTICE OF ALLOWABILITY

PART I.

1. This communication is responsive to 10-30-97
2. All the claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice Of Allowance And Issue Fee Due or other appropriate communication will be sent in due course.
3. The allowed claims are 2 - 3 8
4. The drawings filed on 12 - 21 - 97 are acceptable.
5. Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has [...] been received. [...] not been received. [...] been filed in parent application Serial No. _____ filed on _____
6. Note the attached Examiner's Amendment.
7. Note the attached Examiner Interview Summary Record, PTO-413.
8. Note the attached Examiner's Statement of Reasons for Allowance.
9. Note the attached NOTICE OF REFERENCES CITED, PTO-892.
10. Note the attached INFORMATION DISCLOSURE CITATION, PTO-1449.

PART II.

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" indicated on this form. Failure to timely comply will result in the ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

1. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.
2. APPLICANT MUST MAKE THE DRAWING CHANGES INDICATED BELOW IN THE MANNER SET FORTH ON THE REVERSE SIDE OF THIS PAPER.
 - a. Drawing Informalities are indicated on the NOTICE RE PATENT DRAWINGS, PTO-948, attached hereto or to Paper No. _____ CORRECTION IS REQUIRED.
 - b. The proposed drawing correction filed on _____ has been approved by the examiner. CORRECTION IS REQUIRED.
 - c. Approved drawing corrections are described by the examiner in the attached EXAMINER'S AMENDMENT. CORRECTION IS REQUIRED.
 - d. Formal drawings are now REQUIRED.

Any response to this letter should include in the upper right hand corner, the following information from the NOTICE OF ALLOWANCE AND ISSUE FEE DUE: ISSUE BATCH NUMBER, DATE OF THE NOTICE OF ALLOWANCE, AND SERIAL NUMBER.

Attachments:

- Examiner's Amendment
- Examiner Interview Summary Record, PTO-413
- Reasons for Allowance
- Notice of References Cited, PTO-892
- Information Disclosure Citation, PTO-1449

- Notice of Informal Application, PTO-152
- Notice re Patent Drawings, PTO-948
- Listing of Bonded Draftsmen
- Other

Serial Number: 08/660,805
Art Unit: 2756

-2-

#13
Jill
2/18/98

Part III DETAILED ACTION

An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the Issue Fee.

Pursuant to MPEP 606.01, the title has been changed to read:

--CALL CONTROL IN VIDEO CONFERENCING ALLOWING ACCEPTANCE AND IDENTIFICATION OF PARTICIPANTS IN A NEW INCOMING CALL DURING AN ACTIVE TELECONFERENCE--.

The following is an examiner's statement of reasons for allowance:

Claims 2-38 are allowable over the prior art of record because the prior art of record does not teach or suggest the claimed feature of notifying a receiving participant, during a first active conference call, of a new incoming conference call and identifying each participants in the new incoming conference call.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Serial Number: 08/660,805
Art Unit: 2756

-3-

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Asta can be reached at (703) 305-3817.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

(703) 308-5359 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Dung Dinh
Patent Examiner
February 13, 1998